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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,671	06/26/2001	Derek A. Pratt	N-6636	9766
7590	07/08/2004		EXAMINER	
STITES & HARBISON 424 CHURCH STREET SUITE 1800 NASHVILLE, TN 37219			TRUONG, TAMTHOM NGO	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/891,671	PRATT ET AL.
Examiner	Art Unit	
Tamthom N. Truong	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 June 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 32-42,44-48 and 51-63 is/are pending in the application.  
4a) Of the above claim(s) 53-63 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 32-42,48,51 and 52 is/are rejected.

7)  Claim(s) 44-47 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## FINAL ACTION

Applicant's amendment of 06-14-04 has been fully considered.

Applicant traversed that there was no serious burden of searching and examining new claims 53-63. However, said traversal is not found persuasive for the following reasons:

- A. Claim 53 is drawn to a “*method of stabilizing monomers,...*”, which is not the same as a “*method of reducing the rate of oxidation in a petroleum composition...*” recited in claim 32. Thus, those are distinct and independent inventions as they have different modes of action.
- B. Claim 62 is drawn to a “*method of inhibiting the oxidation of a polymer,...*”, which also differs from the method recited in claim 32 because “*a polymer*” has physical and chemical characteristics that are different from those of “*petroleum*”.

Therefore, a reference that read on the invention of group I would not read on the invention of group II.

- C. A preliminary search done on EAST for the invention of group II yields a total of 31,208 hits. Such a large volume of hits will impose a serious burden of searching, and potential relevant references will be missed.

Because these inventions are distinct for the reasons given above and to search the two distinct inventions (especially group II) would impose a serious burden upon the examiner in charge of this invention, restriction for examination purposes as indicated is proper, and therefore, made FINAL.

Claims 32-42, 44-48, and 51-63 are pending. Claims 53-63 are withdrawn from consideration as being drawn to the non-elected subject matter.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

1. Claims 32-35, 37, 40, 42, 48, 51, and 52 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Henrie, II et. al.** (US'192) as applied to the compounds in the above claims, and further in view of the method taught by **Treybig et. al.** (US'848).

Applicant's argument is not found persuasive for the following reasons:

a. The rejection is based on Henrie, II et. al. in view of Treybig et. al. That is, the teaching of Henrie, II et. al. allows one skilled in the art to make a substituted *4-hydroxy-pyrimidine* as recited in the above claims. However, as for the “*method of reducing the rate of oxidation...*”, one would look to the teaching of Treybig et. al. for the **motivation** to apply Henrie's compounds in the “*method of reducing the rate of oxidation...*”.

Applicant argues the other way around, and thus, the argument is not on point.

b. Regarding the argument that Treybig et. al. do not provide a “*method of reducing the rate of oxidation in a petroleum composition*”, said argument is not valid either. On column 11, Treybig et. al. recognize that there is a “*corrosive well fluids*” (see column 11, line 18) which would damage the metal drilling tool as well as the pipe or storage tank. Further down on the same column, Treybig et. al. disclose useful application to

include “*oil and/or gas well drilling, completion, workover, stimulation, transfer, processing and storage applications.*” (column 11, lines 38-42). Thus, the corrosion inhibitor in the teaching of Treybig et. al. is not used for metal drilling tools alone, but also used for “*the corrosion protection of pipelines, storage tanks, pumps, etc., that exist for the purpose of separating, recovering, oil and/or gas from the produced fluids.*” (column 25, lines 1-7). Note, for the corrosion inhibitor of Treybig et. al. to protect a storage tank, it would have to be placed in the tank or in the oil and/or gas. Therefore, it would have been obvious to the skilled petroleum chemist to use a substituted *4-hydroxypyrimidinyl* compound of Henrie, II et. al. to inhibit the corrosive fluids produced in the oil. It is also well known in the art that the term “*corrosive*” is synonymous with “*oxidized*”. Thus, it would have been within the level of the skilled petroleum chemist to apply the compounds of Henrie, II et.al. in the “*method of reducing the rate of oxidation in a petroleum composition*” to protect storage tanks, and pumps for oil and/or gas as taught by Treybig et.al.

2. Claims 32, 35, 36, 38, 39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over **LaMattina** (US'276) in view of Treybig et. al. (cited above). Like the above rejection, LaMattina discloses the compounds while Treybig et. al. discloses the application of pyrimidinyl compounds (as a class) in the protection of oil and/or gas tanks from the corrosive fluids **produced** by the oil and/or gas. Therefore, it would have been obvious to the skilled chemist to apply the compounds of LaMattina in the “*method of reducing the rate of oxidation in*

*a petroleum composition*" because it is within the level of the skilled petroleum chemist to recognize that the corrosive fluids are produced by the oxidation in a petroleum composition.

***Claim Objections***

3. Claims 44-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The particular compounds recited in claims 44-47 are not disclosed or suggested by Henrie, II et. al. or LaMattina. Therefore, said claims cannot be rendered obvious by the combined teaching of either Henrie, II et. al., or LaMattina with Treybig et. al.

4. **Non-elected Subject Matter:** This application contains claims 53-63 drawn to an invention nonelected with traverse in the reply filed on 6-14-04. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



T. Truong  
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July 2, 2004



RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624